

REMARKS

Entry of this Amendment is proper under 37 C.F.R. § 1.111. Reconsideration of the claims in view of the above amendments and following remarks is respectfully requested.

1. Status of the Claims

Claims 1-12 stand pending and rejected. After entry of the above amendment, claims 1-12 stand cancelled. Applicants have introduced new claims 13-35. Applicants note the new claims are directed to subject matter supported by the original as-filed claims as well as by at least Examples 2-4 of the specification. Introduction of claims as new claims is done for the convenience of the office to present clean claims for review. No prohibited new matter is believed to have been introduced by entry of the amendment. Applicants have canceled claims 1-12 without prejudice to or disclaimer of the canceled subject matter. Applicants reserve the right to file a continuation or divisional application on any subject matter canceled by way of amendment.

2. Information Disclosure Statements

Applicants note with appreciation the acknowledgement of the Information Disclosure Statements filed October 11, 2005, and December 17., 2004.

3. Rejection Under 35 U.S.C. & 112, Second Paragraph

Claims 1-12 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejections stand mooted in view of the cancellation of claims 1-12. Applicants address the rejection to the extent they apply to the new claims. Applicants note that the rejection of claims 1-4 for use of the term "a foam-holding agent," is not applicable to the new claims as the term is not used. Thus, the rejection can be withdrawn.

Regarding the phrase "water and/or ethanol extract of tea leaves", the phrase is no longer recited in the new claims, and therefore the rejection does not apply to the new claims.

Regarding the rejection of claim 3 for the use of Brix degrees. Applicants disagree with the Office's allegation that Brix degrees are specific for dissolved sugar in a solution. The specification sets Brix degrees to mean the relative dry weight of dissolved solids. *See, e.g.*, page 6, lines 17-18 and Example 1. Thus, Brix degrees refers to a relative dry weight of dissolved solids and the solids can be any solid, including sugar. The Office is reminded that Applicants can be their own lexicographer. *See, e.g.*, M.P.E.P. § 2173.01, which states that Applicants can claim the invention in any terms they choose as long as any special meaning assigned to a term is clearly set forth in the specification. Accordingly, in view of the amendments to the claims and above arguments, the rejection should appropriately be withdrawn.

Regarding the phrase "the internal pressure of carbon dioxide", the rejection in view of this phrase is mooted by the new claims, which do not recite the phrase. The rejection can be withdrawn.

Regarding the recitation of "source material" in claim 9, the new claim does not recite the phrase thereby mooted the rejection. The rejection can be withdrawn.

Regarding the clarity of claim 12, this is mooted by cancellation of the claim.

Thus, all the prior rejections under § 112, second paragraph is thereby mooted. The rejection can be withdrawn and the claims allowed.

4. Rejections Under 35 U.S.C. § 102

Claims 1, 5, and 12 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Liu (Chinese Application No. 1237624). Claims 1, 5, and 12 also stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Suzuki et al. (JP Application No. 04356160).

Applicants traverse the rejection to the extent they are applied to the new claims. For a reference to anticipate a claim, each and every limitation must be taught, either expressly or inherently, by the reference. *See*, M.P.E.P. § 2131, citing to *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). Claims 13, 23, and 26 are independent claims. Remaining claims 14-22, 24-25, and 28-35 depend from one of the

independent claims. Claims 13, 23 and 27 recite an amount of tea leaf extract not taught by Liu or Suzuki. Claims 1, 5 and 12 are canceled. Accordingly, Applicants submit that the rejection does not apply to the new claims and can be withdrawn.

5. Refection of the Claims Under 35 U.S.C. 103(a)

Claims 2-4, and 7-11 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over Liu (CN 1237624). Claim 6 stands rejected under 35 U.S.C. § 103(a) as allegedly obvious over Liu in view of Gong (CN 1285153). Claims 2-4, and 7-11 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over Suzuki et al. (JP 04356160). Claim 6 further stands rejected under U.S.C. § 103(a) as allegedly obvious over Suzuki et al. (JP 04356160) in view of Gong (CN 1285153).

The rejections are mooted by the cancellation of claims 1-12. Applicants address the rejections to the extent that they may be applied to the new claims. The cited art did not appreciate that tea possessed foam-holding properties. So there would have been no expectation in the skilled artisan's mind that by introducing a tea extract or amount changing its amount would produce a particular foam-holding property. Applicants note that for adducing a *prima facie* case of obviousness the Office must submit an argument "based on evidence (statutory prior art, admissions against interest)" *In re McKellin*, 188 U.S.P.Q. 428, 432 (C.C.P.A. 1976), emphasis in original. The Federal Circuit Court of Appeals has articulated the requirements of an analysis as:

[W]here claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under § 103 requires, inter alia, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. See *In re Dow Chemical Co.*, ... 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure.

In re Vaeck, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). While KSR modified this standard to include other tests, all the tests required an expectation of success. *See Examination Guidelines for Determining Obviousness under 35 U.S.C. § 103* in view of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57526 at 57528-34 (Oct. 10, 2007).

Applicants submit that in view of the unexpected results obtained, there would have been no reasonable expectation of success at the time. Applicants direct the Office's attention to Table 1 (page 15 of the specification). The table compares the carbon dioxide containing drink samples in which the black tea extract, a hop extract and a Quillaja saponaria extract were added singly or in various combinations. Sample 3 (combination of black tea extract and Quillaja saponaria) showed a longer foam life, i.e., after 10 minutes from being poured into the measuring cylinder having a difference of 570 mL as compared to 520 mL for Sample 7, which lacked the black tea extract. The addition of a hop extract generally adversely affects foam-holding properties. The tea extract suppressed the negative foam holding impact of the hop extract (compare between samples 1 and 4 or samples 2 and 6). Table 2 exemplifies the fact that the foam density ratio for sample 1 was greater than that of sample 4, which did not have the tea extract. No mention is made in Liu, Suzuki, or Gong, when viewed alone or in combination, that tea leaf extracts increase foam-holding properties of carbon dioxide containing drinks.

For Liu, the carbon dioxide containing beverage is actually a tea-cocktail. Thus, Liu provides no expectation that the beverage would have a foam that is foam holding. The Liu Abstract does not suggest the amount of tea extract to be present. The discussion by Liu is purely with regard to enhancing a flavor. The reference does not suggest that the tea extract confers the unexpected property of foam holding. The Office is reminded that inherency cannot serve as part of a proper obviousness rejection. Gong was combined with Liu for Gong's teaching of a tea leaf extract for use with a hop extract. Liu fails to teach the claims for the reasons discussed. Gong fails to cure the defects. Additionally, Gong provides no expectation of success let alone the unexpected property that the foam decreasing nature of hops will be unexpectedly off set by the addition of the tea extract. Unexpected properties are indicia of nonobviousness. The combination of Gong with Suzuki fails similarly. Thus, Liu does not teach

or suggest the claimed invention. When Suzuki is read as a whole, it teaches the addition of a fatty acid ester to a beverage of tea, coffee or juice and homogenization of the beverage to produce a whipped composition. Applicants to not add a fatty acid ester, the foam is naturally occurring due to the pouring of a carbonated beverage. The beverage of Suzuki is not carbonated. For at least these reasons, Suzuki does not suggest the new claims.

Suzuki discloses adding an emulsifier and ethyl alcohol to tea. The resulting composition is subsequently forced to be mixed with air and foamed using a homogenizer. The resultant product is a foamed cream and not a beverage with a foam layer. This whipped cream is not in itself "foam-producing". Applicants note that once the scope and content of the prior art is determined, the relevant inquiry is whether the prior art suggests the invention, and whether one of ordinary skill in the art would have had a reasonable expectation that the claimed invention would be successful. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Both the suggestion of the claimed invention and the expectation of success must be in the prior art, not in the disclosure of the claimed invention. *In re Dow Chemical Co.*, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988). If an explicit suggestion or teaching is missing from a reference, it cannot be supplied by an inherent feature to support an obviousness rejection. *In re Sernaker*, 217 U.S.P.Q. 1 (Fed. Cir. 1983). Inherency is immaterial in an obviousness analysis if the record establishes that one of ordinary skill in the art would not appreciate or recognize the inherent feature. *In re Shetty*, 195 U.S.P.Q. 753 (C.C.P.A. 1977). That which may be inherent is not necessarily known, and obviousness cannot be predicated on what is unknown. *In re Spormann*, 150 U.S.P.Q. 449, 452 (C.C.P.A. 1966). A retrospective view of inherency is not a substitute for some teaching or suggestion in the prior art supporting an obviousness rejection. *In re Newell*, 13 U.S.P.Q.2d 1248 (Fed. Cir. 1989).

Accordingly, Applicants submit the new claims are nonobvious over the cited art. The rejection can accordingly be withdrawn.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is respectfully requested and such action is earnestly solicited. In the event that there are any questions concerning this amendment or the application in general, the Examiner is respectfully requested to telephone the undersigned so that prosecution of the application may be expedited.

If any fees are required, the Office is asked to charge Deposit Account No. 50-0573. The Office can credit any overpayments to the Account.

Respectfully submitted,
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